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201 N. Craig Street
Pittsburgh, PA 15213

MAILED

AUG 31 2010

OFFICE OF PETITIONS

In re Patent of Kotovsky	:	
Patent No. 6,997,267	:	
Issue Date: February 14, 2006	:	Decision on Petition
Application No. 10/090,515	:	
Filing Date: March 1, 2002	:	
Attorney Docket No. KOTOV-10	:	

This is a decision in response to the petition under 37 C.F.R. § 1.377 filed March 12, 2010.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.377."

Procedural Background

The 3.5 year maintenance fee could have been timely paid with the surcharge under 37 C.F.R. § 1.20(h) as late as February 16, 2010.¹

Petitioner, via Attorney Ansel Schwartz, mailed the following items by Express Mail on February 16, 2010:

1. "Notification of Loss of Status as a Small Entity" (1 page),
2. Maintenance fee transmittal letter (2 pages),
3. "Certification of Express Mailing (CEM) 37 C.F.R. § 1.10" (1 page), and
4. A check for \$1060.

Petitioner mailed the items listed above to the following address:

United States Patent and Trademark Office
P.O. Box 371611
Pittsburg, PA 15250-1611

¹ February 14, 2010, was a Sunday and February 15, 2010, was a federal holiday.

The United States Postal Service (“USPS”) returned the Express-Mail Package to Petitioner with the following stamped language added to the envelope: “Return to Sender No Longer at this Box Number.”²

Since the maintenance fee and surcharge were not sent to a correct address the patent expired on February 15, 2010.³

Discussion

As a preliminary matter, the Office notes the 3.5 year maintenance fee for a large entity is \$980, not \$930. Therefore, \$50 has been charged to Deposit Account No. 19-0737 per the general fee authorization in the copy of the original maintenance fee transmittal letter.

MPEP § 2580 states,

A petition under 37 C.F.R. 1.377 would not be appropriate where the entire maintenance fee payment, including any necessary surcharge, was not filed prior to expiration of the patent.

As stated in the language above, the provisions of 37 C.F.R. § 1.377 do not apply unless the record demonstrates the fees were “filed prior to expiration of the patent.”

The petition does not establish the Office physically received the maintenance fee and surcharge mailed February 16, 2010, and then returned the correspondence to the USPS to be returned to Petitioner. Absent proof the Office physically received the fees, the petition must satisfy the requirements set forth in 37 C.F.R. § 1.8(b) and/or 37 C.F.R. § 1.10(e) in order to demonstrate the fees were filed prior to expiration of the patent.

37 C.F.R. § 1.8(b) only applies to correspondence mailed or transmitted in accordance with 37 C.F.R. § 1.8(a) which requires mailed to correspondence to be “[a]ddressed as set out in § 1.1(a),” and 37 C.F.R. § 1.10(e) states the rule only applies to “correspondence addressed as set out in § 1.1(a).” Therefore, the fees cannot be considered timely filed unless the fees were addressed as set out in 37 C.F.R. § 1.1(a).

37 C.F.R. § 1.1 states,

- (a) Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all correspondence must be addressed [as follows]....
- (d) Payments of maintenance fees in patents not submitted electronically over the internet and correspondence related to maintenance fees may be addressed to:

² Although the petition states a copy of the envelope is included as Attachment D, the Office is unable to locate the attachment. However, a copy of the envelope is unnecessary for the Office to treat the merits of the petition.

³ The provisions of 35 U.S.C. § 21 do not extend the expiration date of a patent if the maintenance fee and required surcharge are not timely paid. *See* MPEP § 2506.

Director of the United States Patent and Trademark Office, Attn: Maintenance Fee, 2051 Jamieson Avenue, Suite 300, Alexandria, Virginia 22314.

The fees were not mailed to any of the addresses identified in 37 C.F.R. § 1.1. Therefore, the provisions of 37 C.F.R. § 1.8(b) and 37 C.F.R. § 1.10(e) have not been satisfied and the record fails to establish the fees were filed prior to expiration of the patent. Since the fees were not timely filed prior to expiration of the patent, the petition cannot be granted.

Petitioner asserts the correspondence was sent to the Pittsburgh address because the Office website stated payments of maintenance fees by Express Mail should be sent to the Pittsburgh address. Reliance on the website *might* be able support a showing of unavoidable delay under 37 C.F.R. § 1.378(b). However, such a fact is not the equivalent of proof the correspondence was mailed in compliance with 37 C.F.R. § 1.8(b) or 37 C.F.R. § 1.10(e).

Any request for reconsideration of the instant decision or petition under 37 C.F.R. § 1.378(b), as opposed to a petition under 37 C.F.R. § 1.378(c), should fully discuss of the extent to which Attorney Schwartz's use of the Pittsburgh address was reasonable. For example, was Attorney Schwartz aware the address set forth in 37 C.F.R. § 1.1 for maintenance fee payments was not the Pittsburgh address.

Attorney Schwarz is an attorney of record in the cases listed below. Any request for reconsideration or petition under 37 C.F.R. § 1.378(b) should indicate, for each case, whether or not Schwartz was the party who filed the maintenance fee, and if Schwarz did submit the fee, the mailing address used by Schwarz when submitting the payment.

<u>Patent No.</u>	<u>Maintenance Fee</u>	<u>Date of Submission</u>
6,351,335	7.5 year	January 25, 2010
6,997,574	3.5 year	February 12, 2010
6,373,612	7.5 year	January 25, 2010
6,352,392	7.5 year	January 25, 2010
6,997,558	3.5 year	December 17, 2009
6,406,846	7.5 year	October 19, 2009

If Petitioner does not wish to file a request for reconsideration, petition under 37 C.F.R. § 1.378(b), or petition under 37 C.F.R. § 1.378(c), Petitioner may request a refund of the \$980 maintenance fee and the \$130 surcharge. Any request for a refund should be sent to: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany any request for refund.

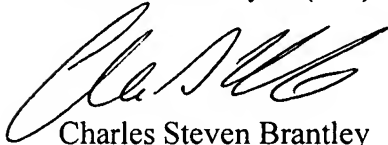
Unless filed by EFS Web, further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney
Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Charles Brantley', written in a cursive style.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions